

REMARKS

The January 12, 2006 Office Action regarding the above-identified application has been carefully considered. The amendments above, the concurrently filed Terminal Disclaimer and these remarks are presented in a bona fide effort to respond thereto and address all issues raised in that Action. The claims have been amended for clarity only. It is believed that revised claim language does not narrow the scope of any amended claim. Care has been taken to avoid entry of new matter. For reasons discussed below, it is believed that this case is in condition for allowance. Prompt favorable reconsideration of this amended application is requested.

Applicant filed three Information Disclosure Statements prior to the January 12, 2006 first Office Action. The first Office Action included document citation forms (PTO- 1449s) from the two latest Statements but not a signed copy of the two pages of such forms from the February 25, 2002 Statement that accompanied the original filing of this application. It is noted that the February 25, 2002 Statement is included in the electronic file of this case available on Public PAIR on the Patent Office website. Hence, it is believed that that Statement was received with the application filing and is in the Official file of this matter. It is requested that the Examiner consider all of the documents cited in various Statements, specifically including the documents cited in the February 25, 2002 Statement, as part of the reconsideration of this application, and that the Examiner indicate consideration by initialing the two pages of forms from the February 25, 2002 Statement alongside all of the citations and returning the initialed document listing pages with the next Official communication regarding this case.

Claims 43 and 44 are pending in this case.

The Examiner rejected claim 43 under the second paragraph of 35 U.S.C. § 112 as indefinite, on the ground that the phrase “an image forming apparatus **which is an example** of

said external device” is confusing because it does not positively indicate the relationship of the apparatus to the claim, i.e. whether the specific apparatus is part of the claim or not. Claim 43 has been amended to eliminate the phrase found objectionable in the Action and to revise the preamble to refer instead to “an external image forming apparatus.” It is respectfully submitted that claim 43 is clear, concise and reasonably definite and that the rejection should now be withdrawn.

Claim 44 has been amended to eliminate a possible non-sequitur. Although not noted in the Action it may be that the phrase “said external device” in the second paragraph arguably did not find antecedent basis within claim 44 itself. Hence, the second paragraph of the claim has been revised to refer instead to “an external device.” It is respectfully submitted that claim 43 is clear, concise and reasonably definite.

The Office Action also rejected claims 43 and 44 for obviousness (non-statutory) type double patenting over claims 1 and 2 of commonly assigned US patent no. 6,111,605, which issued from the parent of this application. Applicant does not necessarily concede that the pending claims are obvious over the claims of the ’605 patent. However, to eliminate the basis for this rejection, a Terminal Disclaimer is filed herewith. Hence, the double patenting rejection should be withdrawn.

Upon entry of the above claim amendments, claims 43 and 44 remain active in this application, both of which should be definite. Also, the non-statutory double patenting rejection should be overcome by the Terminal Disclaimer. Applicant therefore submits that the remaining claims are in condition for allowance. Accordingly, this case should now be ready to pass to issue; and Applicant respectfully requests a prompt favorable reconsideration of this matter.

It is believed that this response addresses all issues raised in the January 12, 2006 Office

10/081,823.

Action. However, if any further issue should arise that may be addressed in an interview or by an Examiner's amendment, it is requested that the Examiner telephone Applicant's representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "Keith E. George", with a stylized flourish at the end.

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